

Appl. No. 10/628 190
Atty. Docket No. NW-1
Amdt. dated 7-14-2004
Reply to Office Action of 6-9-2004

REMARKS

Claims 1-20 are pending in the present application. No additional claims fee is believed to be due.

Claims 2, 4, 11, 15, and 19 are canceled without prejudice.

Claim 1 has been amended to recite "flexible" end tabs "having a suitable shape for insertion into said slots of said folder." Support for this amendment can be found in the Specification at page 12, line 14, and page 14, line 19, respectively.

Claims 7 and 9 have been amended to recite the attachment means for attaching said support portion to the folder near one of said first or second top edges "of the front or rear flap." Support for this amendment can be found at page 10, lines 11-21.

Claim 13 has been amended to recite necessary structure in the preamble. Support for this amendment can be found at page 9, lines 1-2.

Claim 14 has been amended to recite "flexible" end tabs. Support for this amendment can be found at page 12, line 14.

Claim 20 has been amended due to cancellation of Claim 19, and to recite the file marker device having "clear plastic for receiving paper strips." Support for this amendment can be found at page 15, lines 3-4.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Objection to the Drawings

The Office Action States the drawings are objected to under 37 CFR 1.83(a) for not showing "identifying indicia." The claims reciting "identifying indicia" have been cancelled without prejudice in response to this objection.

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Rejection Under 35 USC 102 Over Pieszcchala (US Patent 3, 958,752)

The Office Action States Claims 1-4, 7, 10, 11, 13-15 and 19 are rejected under 35 USC 102(b) as being anticipated by Pieszcchala. For the reasons below, and in light of the above claim amendments, the Applicant respectfully traverses the rejection.

Independent Claim 1 has been amended to recite that the opposed end tabs are flexible. Pieszcchala does not disclose flexible tabs at all, and in any event the Applicant respectfully submits that the "tabs" of Pieszcchala are not "opposed end tabs" at all, as they are not on the support member, but extend from an intermediate portion from the support member.

Independent Claims 1, 7 and 13 have each been amended to remove language such as "adapted for," and to recite the structure such as "front or rear flap" which renders the entire claim limited to file folders as recited in the respective preambles of the independent claims. (Claim 13 has been amended to add structure into the preamble itself.) The amendments ensure that the portion of the claim following the preamble is not a self-contained description of the structure, and, does depend for completeness upon the introductory clause. Kropa v. Robie, 88 USPW 478 (CCPA 1951).

The Office Action states that the preamble of the rejected claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. As stated above, and for the reasons below, the Applicant respectfully disagrees with the Examiner.

In fact, the preamble of the claims as amended do limit the structure of the claimed invention. As stated in the MPEP 2111.02, any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., Coming Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). In the pending Claim 1, for example, the structure "having a suitable shape for insertion into said slots of said folder" clearly depends for completeness upon the introductory recitations in the preamble of the claim. The structure has no meaning outside the recited limitations in the preamble. Likewise, the

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recitation of "front or rear flap" in Claims 7 and 13 clearly depends for completeness upon the introductory recitations in the preamble of the claim.

Therefore, contrary to the assertions in the Office Action, the preamble of each of the pending independent claims "is necessary to give life, meaning, and vitality" to the claim, which according to the MPEP 2111.02, means the preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 183 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

Accordingly, the Applicant respectfully submits that independent Claims 1, 7, and 13, are patentable over Pieszchala. In addition to failing to disclose flexible end tabs having a suitable shape for insertion into slots of a file folder (Claim 1), Pieszchala fails to disclose attachment means for attaching said support portion to the folder near one of said first or second top edges of the front or rear flap (Claim 7) or a substantially U-shaped member for attaching to one of said front or rear flaps (Claim 13), Pieszchala fails to disclose any type of file folder, much less the folder claimed. Because the independent claims are patentable over Pieszchala, the Applicant submits that their respective dependent claims are likewise patentable. The Applicant respectfully requests withdrawal of the rejection over Pieszchala.

Rejection Under 35 USC 102 Over Edwards (US Patent 2, 610,604)

The Office Action states Claims 7, 9, 11, and 12 are rejected under 35 USC 102(b) as being anticipated by Edwards. For the reasons below, and in light of the above claim amendments, the Applicant respectfully traverses the rejection.

As discussed above, the preamble of the pending claims preamble of each of the pending independent claims "is necessary to give life, meaning, and vitality" to the claim, which according to the MPEP 2111.02, means the preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 183 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

Like Pieszchala, Edwards fails to disclose any kind of file folder, much less the folder recited in the rejected claims. Accordingly, the Applicant respectfully submits that independent Claims 7, 9, 11, and 12 are patentable over Edwards. In addition to failing to disclose attachment means for attaching said support portion to the folder near one of said first or second top edges of the front or rear flap (Claim 7), Edwards fails to disclose any

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type of file folder, much less the folder claimed. Therefore, Edwards does not anticipate, and the Applicant respectfully requests withdrawal of the rejection over Edwards.

Rejection Under 35 USC 103(a) Over Pieszchala

Claims 5, 6, 8, 12, 16-18 have been rejected under 35 USC 103(a) as being unpatentable over Pieszchala. Applicants respectfully traverse this rejection for two reasons. First, Pieszchala does not establish a *prima facie* case of obviousness because it does not teach or suggest all of Applicants' claim limitations. Second, there is no motivation to modify Pieszchala to achieve the claimed invention.

Pieszchala does not teach or suggest all of Applicants' claim limitations and therefore, does not establish a *prima facie* case of obviousness (see MPEP 2143.03). Specifically, as discussed above, Pieszchala does not teach or suggest a file folder of any kind, much less the folder recited in the rejected claims. As stated above, the preamble of the rejected claims is "necessary to give life, meaning, and vitality" to the claim, which according to the MPEP 2111.02, means the preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 183 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

Further, there is not motivation in Pieszchala to be modified to be used with a file folder. There is no suggestion or teaching in Pieszchala that the mailbox disclosed therein can, or should, be changed to a file folder, or that the device shown on the mailbox of Pieszchala can, or should, be used on a file folder. There is simply no teaching or suggestion that would lead one to make the necessary modifications to achieve the claimed invention.

Accordingly, the Applicant respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness because it does not teach or suggest all of Applicant's claim limitations. For this reason, the Applicant respectfully requests reconsideration and withdrawal of the claims rejected as being obvious over Pieszchala.

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Rejection Under 35 USC 103(a) Over Pieszcchala in view of Dawson

Claim 20 has been rejected under 35 USC 103(a) as being unpatentable over Pieszcchala over Dawson. Applicants respectfully traverse this rejection because Dawson does not remedy the shortcomings detailed above with respect to Claim 13 (from which Claim 20 now depends). There is surely no motivation to combine such non-analogous art as mailboxes with celluloid windows as the Office Action suggests. Even if all the claimed limitations were taught or disclosed in these two references (which they are not), there is no conceivable motivation to combine these references, and, if combined, the combination would not have any particular utility.

Accordingly, the Applicant respectfully submits that Claim 20 is patentable over the cited art, and respectfully requests reconsideration and withdrawal of the rejection.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 3, 5-10, 12-14, 16-18, and 20.

Respectfully submitted,
Neil L. Weisenfeld

By _____
Roddy M. Bullock
Attorney for Applicant(s)
Registration No. 37,290
(513) 965-8585

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(513) 965-8585

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